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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------------------------------------------------|-------------|----------------------|------------------------|------------------|
| 10/646,138 | 08/22/2003 | Frank Dean | MSH 00257 | 8942 |
| 8131 | 7590 | 07/27/2005 | EXAMINER | |
| MCKELLAR IP LAW, PLLC 784 SOUTH POSEYVILLE ROAD MIDLAND, MI 48640 | | | LARSON, JUSTIN MATTHEW | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3727 | |
| DATE MAILED: 07/27/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/646,138 | DEAN, FRANK | |
| | Examiner | Art Unit | |
| | Justin M. Larson | 3727 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/22/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/11/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The use of the trademark GHOST BRACKET has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The disclosure is objected to because of the following informalities: "Ghost Bracket" on Page 5, Line 24 of the specification is not capitalized.

Appropriate correction is required.

35 USC § 112, 6th paragraph

2. Claim 1 is written in "means plus function" form and since it meets the analysis set forth in MPEP 2181, the Examiner assumes that applicant wishes to invoke 35 USC § 112, paragraph 6.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slifka (5,207,361) in view of Brown (6,698,635). Slifka teaches a golf bag carrier for a

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motorcycle that uses a support base (4), mounted at the rear foot peg, and straps (10 and 18) that secure the golf bag to the motorcycle frame rather than an elongated mounting frame that is secured to the motorcycle by bolts and has two U-shaped support members to hold the golf bag in place. Brown, however, teaches a golf bag attachment for motorcycles comprising an elongated mounting frame (2, 4, 40, and 42), two U-shaped support members (8 and 10) spaced apart and extending laterally from the mounting frame member, and a plurality of passageways through the mounting frame member as seen in Figure 3, through which a fastening means secures the golf bag-holding frame to the frame of the motorcycle, utilizing the saddlebag mounting brackets as seen in Figures 1 and 2. Therefor, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Slifka by using a more rigid and sturdy support rack, as taught by Brown, and modifying Brown's support brackets (2 and 4) in such a way as to allow the carrier to be attached to the motorcycle's saddlebag brackets, in order to more securely fasten the golf bag and further limit the golf bag's ability to shift along the side of the motorcycle while the motorcycle was in motion which may have thrown off the rider's balance and placed him/her in danger.

5. In regard to the limitations set forth in claim 3, Official Notice is take that it is old in the art and commonly known to use threaded bolts when securing a rack or carrier to a supporting surface and that a person of ordinary skill in the art at the time the invention was made would therefor have known to use threaded bolts to attach the golf

bag carrier to the motorcycle frame in order to provide a secure and dependable attachment.

6. Also, regarding the limitations set forth in claims 4-9 and 11, even though Slifka in view of Brown fails to define an angle or range of angles that would be formed between the U-shaped support members aligned with the foot pegs and the longitudinal axis of the motorcycle, it would have been obvious to one having ordinary skill in the art at the time the invention was made to determine the appropriate angle based on the weight and dimensions of the carrier and/or the golf bag itself in order to maintain an appropriate center of gravity for the motorcycle/carrier assembly, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Everett, Jones, Wesson, Meyer, Ward, Laesch, Sirey, Hann, Hancock, and Schurr all disclose related carriers or material related to mounts on either a motorcycle or ATV. Schurr, in particular, discloses a golf bag carrier intended to be used on the side of a motorcycle, attached via the saddlebag mounts.

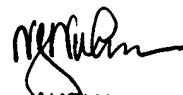
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571) 272-8649. The examiner can normally be reached on M-Th 6-4:30.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571)272-4544. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



NATHAN J. NEWHOUSE
PRIMARY EXAMINER